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Serial No. 10/062,785

REMARKS

This amendment responds to the Office Action dated August 11, 2004. Claims 1, 2, 11, 15 and 23 have been amended to more clearly specify the claimed invention in response to a request by the Examiner. The remaining claims remain unchanged from the original or previously amended versions.

CLAIMS 1, 2, 11, 15 AND 23 ARE NOT OBJECTIONABLE

The Examiner objected to claims 1, 2, 11, 15 and 23 under 37 C.F.R. § 1.75(a) and required certain amendments. The Applicant has amended these claims in accordance with the Examiner's remarks. Reconsideration and withdrawal of the objection to claims 1, 2, 11, 15 and 23 is therefore respectfully requested.

CLAIMS 1-2 AND 4-23 ARE PATENTABLE OVER SULLIVAN ET AL., JAMBHEKAR ET AL. AND AKIOKA ET AL. EITHER TAKEN ALONE OR IN ANY COMBINATION

The Examiner rejected claims 1-2 and 4-23 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,593,973 to Sullivan et al. [hereinafter "Sullivan et al."] in view of U.S. Patent No. 5,848,356 to Jambhekar et al. [hereinafter "Jambhekar et al."] and further in view of European Patent Application No. EP 0 852 371 A1 to Akioka et al. [hereinafter "Akioka et al."]. Essentially, the Examiner contends that Sullivan et al. discloses all of the elements of the claims at issue, except for an input device of a combination of an input module and a communication module, adapted to receive, to store an instruction corresponding to a graphic data and to transmit graphic data to a remote server, and both the graphic data and the received broadcast video data simultaneously displayed on the display device." The Examiner then cites Jambhekar et al. as providing some of this missing teaching, in particular, the input device comprising an input module adapted to receive and to store an instruction corresponding to a graphic data and a communication module for transmitting graphic data to a remote server. The Examiner then contends it would have been obvious to combine the teachings

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of Jambhekar et al. and Sullivan et al. because this would provide a user an easier way to compose and to transmit this message to others. But the Examiner notes that this combination of Sullivan et al. and Jambhekar et al. fails to teach both the graphic data and the received broadcast video being simultaneously displayed on the display device. The Examiner then cites Akioka et al. as providing this missing teaching, and further contends that it would have been obvious to add this teaching from Akioka et al. to the combination of Sullivan et al. and Jambhekar et al. because this would allow the user simultaneously to view a plurality of image sources on the display device. The Applicant respectfully disagrees with the Examiner's characterization of these references vis-à-vis the claims at issue.

Assuming *arguendo* that Sullivan et al., Jambhekar et al. and Akioka et al. disclose the combination of elements set forth in the claims at issue, Sullivan et al. cannot be combined with Jambhekar et al. and Akioka et al. to arrive at the claimed invention because it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In sum, Sullivan et al. teaches away overlaying graphics on a video because Sullivan et al. states one must insert an alternate video source (as opposed to a graphic) during a transition period – not just during any part of the video source. Thus, Sullivan et al. teaches that any replacement or “overlaying” must occur during a transition period. This teaches away from overlaying a graphic on the video to create a combined video and graphic because during a transition period no video is being displayed. As mentioned above, the present invention enables the overlaying of a graphic generated by a handheld user input device onto a video source so that the combined video (*i.e.*, not simply a blank screen) and graphic is displayed. As Sullivan teaches away from combining a graphic with a video during a non-transition period any combination (such as Sullivan et al., Jambhekar et al. and Akioka et al.) that would purport to overlay video and graphics that would include Sullivan et al. is not proper.

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Reconsideration and withdrawal of the rejection of claims 1-2 and 4-23 is therefore respectfully requested.

**CLAIM 3 IS PATENTABLE OVER
SULLIVAN ET AL., JAMBHEKAR ET AL. AND DAILEY**

The Examiner rejected claims 3 under 35 U.S.C. §103(a) as being unpatentable over Sullivan et al. in view of Jambhekar et al. and Akioka et al. (as combined above) and further in view of U.S. Patent No. 5,642,350 to Dailey [hereinafter "Dailey"]. Essentially, the Examiner contends that the above combination of Sullivan et al. and Jambhekar et al. discloses all of the elements of the claims at issue, except "teaching a plurality of remote display interfaces arranged in a peer-to-peer network." The Examiner then cites Dailey as providing this missing teaching. Finally, the Examiner contends that it would have been obvious to one of ordinary skill in the art "to provide a plurality of remote display interfaces arranged in a peer-to-peer network in the device of Sullivan because this would permit every device on the network to initiate as well as receive messages from other devices on the network, as taught by Dailey." The Applicant respectfully disagrees with the Examiner's characterization of these references vis-à-vis the claim at issue.

As Sullivan teaches away from combining a graphic with a video during a non-transition period any combination (such as Sullivan et al., Jambhekar et al., Akioka et al. and Dailey) that would purport to overlay video and graphics that would include Sullivan et al. is not proper. Reconsideration and withdrawal of the rejection of claim 3 is therefore respectfully requested.

**CLAIMS 1-2 AND 4-23 ARE PATENTABLE OVER
SULLIVAN ET AL., JAMBHEKAR ET AL. AND De HAAN EITHER TAKEN ALONE
OR IN ANY COMBINATION**

The Examiner rejected claims 1-2 and 4-23 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,593,973 to Sullivan et al. [hereinafter "Sullivan et al."] in view of U.S. Patent No. 5,848,356 to Jambhekar et al. [hereinafter "Jambhekar et al."] and

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further in view of U.S. Patent Application No. 2003/0117529 A1) to De Haan [hereinafter "De Haan"]. Essentially, the Examiner contends that Sullivan et al. discloses all of the elements of the claims at issue, except for an input device of a combination of an input module and a communication module, adapted to receive, to store an instruction corresponding to a graphic data and to transmit graphic data to a remote server, and both the graphic data and the received broadcast video data simultaneously displayed on the display device." The Examiner then cites Jambhekar et al. as providing some of this missing teaching, in particular, the input device comprising an input module adapted to receive and to store an instruction corresponding to a graphic data and a communication module for transmitting graphic data to a remote server. The Examiner then contends it would have been obvious to combine the teachings of Jambhekar et al. and Sullivan et al. because this would provide a user an easier way to compose and to transmit this message to others. But the Examiner notes that this combination of Sullivan et al. and Jambhekar et al. fails to teach both the graphic data and the received broadcast video being simultaneously displayed on the display device. The Examiner then cites De Haan as providing this missing teaching, and further contends that it would have been obvious to add this teaching from De Haan to the combination of Sullivan et al. and Jambhekar et al. because this would allow the user simultaneously to view a plurality of image sources on the display device. The Applicant respectfully disagrees with the Examiner's characterization of these references vis-à-vis the claims at issue.

Assuming *arguendo* that Sullivan et al., Jambhekar et al. and De Haan disclose the combination of elements set forth in the claims at issue, Sullivan et al. cannot be combined with Jambhekar et al. and De Haan to arrive at the claimed invention because it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). In sum, Sullivan et al. teaches away overlaying graphics on a video because Sullivan et al. states one must insert an alternate video source (as opposed to a

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CLAIM 3 IS PATENTABLE OVER

SULLIVAN ET AL., JAMBHEKAR ET AL., De HAAN AND DAILEY

The Examiner rejected claims 3 under 35 U.S.C. §103(a) as being unpatentable over Sullivan et al. in view of Jambhekar et al. and De Haan. (as combined above) and further in view of U.S Patent No. 5,642,350 to Dailey [hereinafter “Dailey”]. Essentially, the Examiner contends that the above combination of Sullivan et al., Jambhekar et al. and De Haan discloses all of the elements of the claims at issue, except “teaching a plurality of remote display interfaces arranged in a peer-to-peer network.” The Examiner then cites Dailey as providing this missing teaching. Finally, the Examiner contends that it would have been obvious to one of ordinary skill in the art “to provide a plurality of remote display interfaces arranged in a peer-to-peer network in the device of Sullivan because this would permit every device on the network to initiate as well as receive messages from other devices on the network, as taught by Dailey.” The Applicant respectfully disagrees with the Examiner’s characterization of these references vis-à-vis the claim at issue.

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would purport to overlay video and graphics that would include Sullivan et al. is not proper.
Reconsideration and withdrawal of the rejection of claim 3 is therefore respectfully requested.

CONCLUSION

The Applicants respectfully submit this application is in condition for allowance and request issuance of a Notice of Allowability.

In the event the prosecution of this application can be efficiently advanced by a phone discussion, it is requested that the undersigned attorney be called at (703) 435-9390.

FEES

If additional amounts are due following the amendments made to the claims above, or for any other reason, it is respectfully requested that the PTO charge any deficiency or credit any overpayment to the deposit account of Mayer Fortkort & Williams PC, Deposit Account, #50-1047.

Respectfully submitted,

By 
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Date: November 12, 2004

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